

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ERICSSON INC. AND TELEFONAKTIEBOLAGET LM ERICSSON  
Petitioner

v.

INTELLECTUAL VENTURES II LLC  
Patent Owner

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Case IPR2018-01380  
U.S. Patent No. 8,682,357

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JOINT MOTION TO TERMINATE PROCEEDING

Petitioner Telefonaktiebolaget LM Ericsson and Ericsson Inc. and Patent Owner Intellectual Ventures II LLC have reached a settlement agreement and jointly request termination of IPR2018-01380 under 35 U.S.C. § 317(a). The Board authorized the filing of this motion on June 13, 2019.

**I. Statement of Relief Requested**

Due to a settlement, Petitioner and Patent Owner jointly request termination of IPR2018-01380 under 35 U.S.C. § 317(a).

**II. Statement of Facts**

Petitioner and Patent Owner have reached an agreement to settle this *inter partes* review proceeding. Petitioner and Patent Owner are filing the settlement agreement concurrently with this motion, along with a “Joint Request That the Settlement Agreement Be Treated as Business Confidential and Key Separate Under 35 U.S.C. § 317(b).” A joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (P.T.A.B. July 28, 2014).

(1) Brief Explanation.

Termination is appropriate in this case because the parties have settled their dispute. A “Joint Request That the Settlement Agreement Be Treated as Business Confidential and Kept Separate Under 35 U.S.C. § 317(b)” is being filed concurrently with this motion.

(2) Related Litigation.

The '357 Patent is subject to pending lawsuits entitled *Intellectual Ventures II LLC v. T-Mobile USA, Inc. et al.*, Case No. 2:17-cv00661-JRG (E.D. Tex.) and *Intellectual Ventures II LLC v. Sprint Spectrum, L.P.*, Case No. 2:17-cv-662-JRG (E.D. Tex.) (the “Litigation”).

(3) Related Proceedings Before the Office.

In addition to IPR2018-01380, Petitioner and Patent Owner are aware of the following *inter partes* review proceedings involving the '357 Patent: *T-Mobile USA, Inc. et al. v. Intellectual Ventures II LLC*, IPR2018-01775, and *Nokia of America Corp. v. Intellectual Ventures II LLC*, IPR2019-00667.

(4) Status of Related Litigation and Proceedings Before the Office.

The related district court proceeding awaits trial but is stayed pending settlement between the parties. T-Mobile’s petition for *inter partes* review was denied institution, and Nokia jointly moved with Patent Owner to terminate, which

the Board granted: *T-Mobile USA, Inc. et al. v Intellectual Ventures II LLC*, IPR2018-01775, Paper 10 at 1 (PTAB Mar. 18, 2019); and *Nokia of America Corp. v. Intellectual Ventures II LLC*, IPR2019-00667, Paper 10 at 1 (PTAB May 6, 2019).

### **III. Argument**

The Board should terminate this *inter partes* review for the following reasons.

First, Petitioner and Patent Owner have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under § 317(a), an *inter partes* review “shall” be terminated upon a joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions of § 317(a).

Second, the parties have reached a settlement as to all the disputes in this proceeding. A true copy of the settlement agreement is filed concurrently herewith. *See* Ex. 1026. The parties request that the settlement agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). No other such agreements, written or oral, exist between or among the parties.

Accordingly, the parties in the present proceeding jointly certify that there are no other written or oral agreements or understandings, including any collateral agreements, between them, including but not limited to licenses, covenants not to sue, confidentiality agreements, payment agreements, or other agreements of any kind, that are made in connection with or in contemplation of, the termination of this proceeding.

Third, a termination of this proceeding will conserve the Board's resources and obviate the need for any more Board involvement in this matter.

#### **IV. Conclusion**

For these reasons, Petitioner and Patent Owner respectfully request termination of this *inter partes* review of the '357 Patent.

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